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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/798,635 | 03/11/2004 | Frank Venegas JR. | IDS-17102/14 | 6673 |

25006 7590 11/07/2006

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EXAMINER

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ART UNIT PAPER NUMBER

3636

DATE MAILED: 11/07/2006

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/798,635
Filing Date: March 11, 2004
Appellant(s): VENEGAS, FRANK

John G. Posa
Gifford, Krass, Groh, Sprinkle, Anderson & Citkowski, P.C.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11 September 2006 appealing from the Office action mailed 07 April 2006. The Office action was made FINAL as noted on the Office Action Summary (PTO-326).

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. The statement does not mention the status of the amendment. As noted on the recently mailed Advisory Action (PTOL-304) the amendment has not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct. Additionally, prosecution was based on the 15 September 2005 election of the species depicted in FIG. 5.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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(7) Claims Appendix

A substantially correct copy of appealed claim 1 appears on the first page of the Appendix A to the appellant's brief. The minor errors are as follows:

Claim 1, lines 8 and 10: [[the material spanning the infill area]] should be a material spanning the infill area.

(8) Evidence Relied Upon

| | | |
|-----------------|-------------|---------|
| US-4787603 | Norton | 11-1988 |
| US-2003/0178614 | Venegas Jr. | 09-2003 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Norton (US-4787603).

Claim 1*: Norton discloses an energy-absorbing barrier system comprising an infill area (FIG. 2) spanned by interconnected vertical metal pipes (54, 55) and horizontal metal pipes (50, 53) where some portion of the vertical pipes is buried below a ground surface (FIGS. 2, 4); and the infill material (column 5, lines 5-7) secured to the vertical or horizontal pipes by tethers (metal wires; column 2, lines 5-10).

* The following minor informalities are noted: The recitation of "a material spanning the infill area" at lines 8 and 10 has been interpreted to be the same element as "a material spanning the infill area" recited at line 6.

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Claim 2: Norton discloses one or more of the pipes are filled with cement (concrete; column 5, lines 37-39). A pipe inherently fills with cement (concrete) upon its insertion into the wet cement (concrete).

Claim 3: Norton discloses pipes of steel (column 5, lines 14-15).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norton (US-4787603) as applied to claim 1 above, and further in view of Venegas Jr. (US-2003/0178614).

Claim 4: Norton discloses an energy absorbing barrier system comprising metal pipes, but lacks the plastic cover.

Venegas Jr. teaches metal pipes covered with plastic (FIG. 1; page 1 [0007]; page 5 [0057] mentions the plastic “provides a protective coating, seals the assembly, improves the aesthetic appearance, reduce maintenance, and provides a unique appearance”).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Norton by using pipes covered with a plastic cover over one or more of the pipes for a protective coating, sealing the assembly, and reducing maintenance, such as corrosion prevention, in order for the pipes to have a longer life.

(10) Response to Argument

Appellant's arguments filed 11 September 2006 have been fully considered but they are not persuasive.

In response to appellant's argument that Norton fails to include pipes that are buried below a ground surface, clearly the claim does not intend to include the ground. As such, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the Norton reference the pipe is below a ground surface, e.g., the upper surface of the base unit.

In response to appellant's argument that the mounts break away upon a predetermined force, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the Norton reference attachment by means of metal wires would break away upon a predetermined force, for example the replacement of wire mesh infill material that is damaged during assembly would require removal of the material by using a predetermined force to break away the means of metal wire used to attach the material (barrier element mesh or chicken wire) to the pipes (frame).

In response to appellant's argument that the Norton metal wire attachment provides no control over uncontrolled travel upon impact, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The claim does not require impact because it is a product claim, not a process claim. In the Norton reference, the attachment

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by means of metal wire inherently provides control over uncontrolled travel upon *impact* because the metal wire is an attachment that secures the infill material (mesh or chicken wire) to the pipe (frame) thus preventing uncontrolled travel. As noted above, an impact step is not claimed.

In response to appellant's argument that Norton fails to disclose a pipe filled with cement (concrete), the recitation filled has been given its broadest reasonable interpretation and Norton discloses at least a portion of the pipe is inherently filled with cement (concrete) when the pipe is inserted into the wet concrete of the base unit. The claim does not structurally define over the Norton reference which includes at least a portion of the pipe to be inherently filled with cement (concrete).

In response to appellant's argument that the pipe filled with cement requires that the cement (concrete) be poured into the pipe until no more cement (concrete) can be received has been interpreted as a product by process limitation. As such, the pipe structure of Norton that is inherently filled with cement (concrete) as noted in the preceding paragraph meets the positively structural limitations of the product by process claim. The process by which the pipes are filled, whether by inserting into wet concrete (as in Norton) or pouring concrete into the pipe, is not a patentable distinction in the product claim.

In response to appellant's argument that the obviousness rejection applied to claim 4 lacks support or, in other words, that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's

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disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The motivation or support for modifying the pipes of Norton to include a plastic cover is found explicitly in Venegas Jr. which in the last sentence of paragraph 0057 states that the plastic coating on a metal pipe provides a protective coating, seals the assembly, improves the aesthetic appearance, reduces maintenance, and provides a unique appearance. Each of these is motivation for modifying Norton to include a plastic cover. In the final rejection, the mention of corrosion prevention in the rejection of claim 4 is one exemplary benefit associated with the explicitly stated benefits of “protective coating,” “seals the assembly,” and “reduce maintenance” mentioned in Norton since corrosion of metal is known to occur when metal is unprotected from weather.

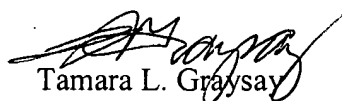
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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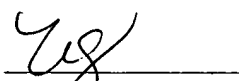
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Tamara L. Graysay

Conferees:

Naoko N. Slack



Peter M. Cuomo

